

Amendment And Response Under 37 C.F.R. §1.116
Serial No. 10/600,966

REMARKS

Claims 19-32 and 42-62 are pending in the present application. By this Amendment, previously presented claims 19, 26 and 55 have been amended. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendment and the following remarks.

Entry of the above amendments is proper under 37 C.F.R. §1.116 (a) in that the above amendments (1) place the claims in condition for allowance; (2) place the claims in better condition for consideration on appeal, if necessary; (3) do not raise any new issues; and (4) do not add new claims without canceling a corresponding number of claims. It should be noted that the above amendments to previously presented claims 19, 26 and 55 were made in order to: (1) incorporate claim features of previously presented claims 23 and 24 into previously presented claim 19, the subject matter of which has been previously considered and is currently rejected by Examiner Juska in view of the proposed combination of the teachings of Yamanashi, Bye and Giovanelli discussed below; (2) rewrite previously presented claim 26 in independent form; and (3) conform the claim language of dependent claim 55 more closely with the language used in the original specification, the difference between the previously presented claim language and the language of the original specification being noted by Examiner Juska in the November 02, 2005 final Office Action. For the reasons given above, entry of the above amendment under 37 C.F.R. §1.116 is respectfully requested.

I. Formal Matters:

Indication of Allowable Subject Matter

Applicants thank Examiner Juska for indicating that claims 59-62 are allowed, and that dependent claims 26-32 and 48 would be allowable if rewritten in independent form including the claim features of any base claim and any intervening claims. As shown above, previously presented claim 26 has been rewritten in independent form.

For at least the reasons given below, it is respectfully submitted that the remaining claims, claims 19-25, 42-47, and 49-58, are also allowable in view of the art of record.

Rejection of Previously Presented Claim 55 Under 35 U.S.C. §112, 1st Paragraph

Previously presented claim 55 was rejected under 35 U.S.C. §112, 1st paragraph as allegedly failing to comply with the written description requirement. Previously presented claim 55 has been amended as shown above to recite language similar to that found in the original specification at page 8, lines 13-14.

II. Prior Art Rejections:

Rejection of Previously Presented Claims 19-25, 42-47 and 49-58 Under 35 U.S.C. §103(a) In View Of Yamanashi In Combination With Bye and Giovanelli

Previously presented claims 19-25, 42-47 and 49-58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Great Britain Patent Specification No. 1,169,621 to Yamanashi Kasei Kogyo Company (hereinafter, "Yamanashi") in view of U.S. Patent No. 4,451,419 issued to Bye et al. (hereinafter "Bye") and U.S. Patent No. 3,976,820 issued to Giovanelli et al. (hereinafter "Giovanelli"). This rejection is respectfully traversed.

Examiner Juska rejects each of independent claims 19, 42 and 56 in view of the proposed combination of teachings of Yamanashi, Bye and Giovanelli. It is respectfully submitted that the proposed combination of the teachings of Yamanashi, Bye and Giovanelli, even if proper, fails to teach, disclose or suggest at least the following claim features recited in independent claims 19, 42 and 56:

(1) a method of producing a unitary polymer substrate having a napped surface, wherein the method comprises providing a resilient template surface comprising a release material and having a plurality of microdepressions therein, wherein the resilient template surface comprises a polymer foam or a silicone rubber (claim 19);

(2) a method of producing a unitary polymer substrate having a napped surface, wherein the method comprises providing a resilient template surface having a plurality of microdepressions therein (claim 42); and

(3) a method of producing a unitary polymer substrate having a napped surface, wherein the method comprises providing a resilient template surface having a plurality of undercut-shaped microdepressions therein (claim 56).

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Each of the teachings of Yamanashi, Bye and Giovanelli fails to teach, disclose or suggest the use of a resilient template surface in a method for forming a unitary polymer substrate having a napped surface. Regarding this recited claim feature, Examiner Juska specifically states on page 6, lines 1-12 of the November 02, 2005 final Office Action:

Additionally, it would have been readily obvious to one skilled in the art to substitute silicone rubber as the release material in order to provide resiliency while maintaining the release feature. Silicone rubber is a release material known to be equivalent to PTFE. Thus, it would have been obvious to one skilled in the art to substitute silicone rubber for the release surface, since the equivalence of silicone rubber and PTFE as release materials is well-known in the art. As such, the choice of any of these equivalents is within the level of ordinary skill in the art. Therefore, claims 22, 24, 25, 42, 43, 46, 47, 49-52, 56 and 58 are rejected.

Furthermore, it would have been obvious to one skilled in the art to employ a polymer foam or a screen release material as the resilient material since it has been held to be within the general skill of a worker in the art to select a known material on a basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore, claims 23, 44, 45, 53, 54, and 57 are rejected as being obvious over the cited prior art.

Applicants disagree.

First, Applicants respectfully submit that silicone rubber is not known as an equivalent to PTFE. There is no suggestion in the art of record (or any other art known by Applicants) of the alleged equivalence of silicone rubber and PTFE. Second, and most important to the present rejection, there is no suggestion in any of the teachings of Yamanashi, Bye or Giovanelli of the use of a resilient surface material as a component of, or in place of, the heated rolls disclosed in Yamanashi, Bye and Giovanelli. There simply is no suggestion in any of the teachings of Yamanashi, Bye or Giovanelli of the use of a resilient surface material, such as a silicone rubber, a polymer foam or a screen release material, as a component of the heated rolls disclosed in Yamanashi, Bye and Giovanelli.

Examiner Juska suggests that one of ordinary skill in the art, given the teaching of Yamanashi, would have (1) sought out the teachings of Bye and Giovanelli, (2) modified the heated roll disclosed in the method of Yamanashi by utilizing PTFE, as disclosed in the teachings

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of Bye and Giovanelli, as a release material on the heated roll disclosed in Yamanashi, and (3) then further modify the previously modified heated roll by substituted silicone rubber for the PTFE given the alleged equivalence of silicone rubber and PTFE, and optionally (4) even further modify the re-modified heated roll by substituting a polymer foam or screen release material for the silicone rubber component of the resulting re-modified heated roll. Applicants disagree.

Applicants respectfully submit that there is no suggestion of the need or desire to utilize a resilient surface material, a silicone rubber, a polymer foam, or a screen release material as a fiber-forming surface in the disclosed methods of Yamanashi, Bye or Giovanelli. As stated by the Court in *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (In *Mills*, claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id.* at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Applicants respectfully submit that not only does the prior art fail to suggest the desirability of the proposed combination of references and the proposed modification of the disclosed heated roll in Yamanashi, the prior art fails to even suggest the claim features (e.g., a resilient surface template) necessary for completing the proposed modification of the disclosed heated roll in Yamanashi.

It is unclear to Applicants why one of ordinary skill in the art, given the teaching of Yamanashi, would have (1) sought out the teachings of Bye and Giovanelli, (2) reviewed the teachings of Yamanashi, Bye and Giovanelli, and then (3) decided to modify the heated roll disclosed in the method of Yamanashi as suggested by Examiner Juska (i.e., incorporated a resilient surface material into the heated roll disclosed in the method of Yamanashi or substituted a resilient surface material for the heated roll disclosed in the method of Yamanashi). Applicants

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respectfully submit that the only motivation for incorporating a resilient surface material into the disclosed method of Yamanashi has been gleaned from Applicants' claimed invention, not what is taught, disclosed or suggested in the art of record. As noted by the Court, "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention", *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

For at least the reasons given above, Applicants respectfully submit that a *prima facie* case of obviousness has not been made, and that the proposed combination of the teaching of Yamanashi with the teachings of Bye and Giovanelli, even if proper, fails to make obvious Applicants' claimed invention as embodied in independent claims 19, 42 and 56. Since claims 20-25, 43-47, 49-55 and 57-58 depend from independent claims 19, 42 and 56, and recite additional claim features, Applicants respectfully submit that the proposed combination of the teaching of Yamanashi with the teachings of Bye and Giovanelli also fails to make obvious claims 20-25, 43-47, 49-55 and 57-58. Accordingly, Applicants respectfully request withdrawal of this rejection.

III. Conclusion:

For at least the reasons given above, Applicants submit that claims 19-32 and 42-62 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

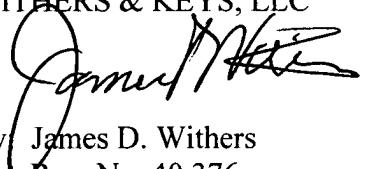
No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

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Should Examiner Juska believe that anything further is necessary to place the application in better condition for allowance, Examiner Juska is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

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